

**REMARKS:**

Claims 6 and 48 have previously been cancelled. Claims 1-5 and 7-47 are pending in the present Application.

Claims 1-5 and 7-47 stand rejected under 35 U.S.C. § 103(a) over Shekhar Iyer, et al., "Automated retrieval and ranking of similar parts in agile manufacturing," IIE Transactions 29 859-876 (1997) ("Iyer").

This rejection is respectfully traversed.

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP 2142. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.... Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *Id.*

Thus, in order to establish a *prima facie* case of obviousness, an office action must include, based on factual support, a showing that (1) there is some suggestion or motivation to modify a reference, (2) there is a reasonable expectation of success, and (3) all claim limitations are taught or suggested by prior art.

With respect to the first element (i.e., suggestion or motivation to modify), it is respectfully submitted that the present Office Action fails to include a showing based on factual support that there exists any suggestion or motivation to modify Iyer. The Office Action states that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Iyer to include two expressions to represent a range of similarity values wherein the center of the range is an exact match." However, the Office Action does not explain *why* it would have been obvious to make this modification. In

other words, the Office Action provides no suggestion or motivation for modifying Iyer as proposed. Therefore, for at least this reason, it is respectfully submitted that the Office Action fails to establish a *prima facie* case of obviousness.

With respect to the second element (i.e., reasonable expectation of success), the Office Action is silent with respect to this element. Therefore, for at least this additional reason, it is respectfully submitted that the Office Action fails to establish a *prima facie* case of obviousness.

With respect to the third element (i.e., all claim limitations being taught or suggested by prior art), the Office Action fails to show that all elements of the present claims are taught or suggested by prior art. For example, the Office Action concedes that Iyer fails to disclose or suggest “each attribute similarity value is calculated according to either a first expression or a second expression depending on whether the attribute value for the potential alternative product is less than or greater than the desired attribute value for the requested product.” The Office Action fails to show that this limitation is taught or suggested by prior art. Therefore, for at least this additional reason, it is respectfully submitted that the Office Action fails to establish a *prima facie* case of obviousness.

Further with respect to the third element, it is noted that the Office Action relies on alleged common knowledge in the art, which amounts to a taking of official notice, with respect to the limitation of claim 1 that reads “each attribute similarity value is calculated according to either a first expression or a second expression depending on whether the attribute value for the potential alternative product is less than or greater than the desired attribute value for the requested product” and similar limitations of the other claims. Applicant hereby traverses this taking of Official Notice because the asserted facts are not supported by documentary evidence and appear to be the Examiner’s opinions formulated using the present application as a template, which constitutes impermissible use of hindsight.

“Official Notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While ‘official notice’ may be relied upon, these circumstances should be rare when an application is under final rejection or action

under 37 C.F.R. 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy the dispute'(citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." MPEP § 2144.03(A) (emphasis in original).

"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03(A) (emphasis in original).

The Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of "instant and unquestionable" demonstration as being well-known. Thus, if the Examiner continues to maintain the rejection of claims 7-12 based on the Official Notice, the Applicant requests that the Examiner provide documentary evidence as stated in Section 2144.03 of the M.P.E.P. Further, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. (See MPEP § 2144.03(C)).

With respect to independent claims 5 and 33, each of these claims includes limitations similar to those discussed above in connection with claim 1. Thus, the arguments presented above in connection with claim 1 apply equally to claims 5 and 33, as well as their dependent claims.

For the reasons set forth herein, it is respectfully submitted that the Office Action fails to establish a *prima facie* case of obviousness of claims 1-5 and 7-47. Therefore, it is respectfully requested that the rejection of claims 1-5 and 7-47 be reconsidered and that claims 1-5 and 7-47 be allowed.

## **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any

motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**


In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

13 MARCA 2006  
Date

  
James E. Walton, Registration No. 47,245  
Daren C. Davis, Registration No. 38,425  
Brian E. Harris, Registration No. 48,383  
Michael Alford, Registration No. 48,707  
Steven J. Laureanti, Registration No. 50,274  
Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)  
jim@waltonpllc.com (e-mail)

**CUSTOMER NO. 53184**  
**ATTORNEYS AND AGENTS FOR APPLICANT**